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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/537,176 03/29/00 CAERAN

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007055 QM12/0920  
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EXAMINER

MOHANDESI, J

ART UNIT

PAPER NUMBER

3728

DATE MAILED:

09/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.

09/537,176

Applicant(s)

CAERAN, MARCO

Examiner

Jila M. Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 19,20 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claim 28 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: it is directed to a method of assembling a sports boot requiring the step of laying flat the external upper and the affixed flexible frame.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 28 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. It is noted that the term “sports boot” in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

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4. Claims 1-15, 18, 24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Reinhart et al. (2,261,453). Reinhart '453 discloses a boot comprising an outer sole **B** and an external upper **A** covering a user's foot and lower leg, the external upper comprising a flexible frame **C** made of a flexible, substantially non-stretchable material (leather), arranged along determinate directions of forces transmitted during use of the boot, said flexible frame being affixed to both the external upper and the outer sole. Note the lateral arms **1**.

With regard to the dorsal portion extending from the outer sole, see Figure 3.

5. Claims 1-3, 5, 13-14 and 21-27 rejected under 35 U.S.C. 102(b) as being anticipated by Spier (3,807,062). Spier '062 discloses all the limitations of the claims such as a sports boot comprising an outer sole **32** and an external upper **22** overlying the outer sole and covering a user's foot and lower leg, the upper including a flexible, substantially non-stretchable frame **21**. Note that the cutout **28** eliminates the rigidity in frame **21**, which would otherwise limit flexing of the ankle with respect to the foot in the forward direction at the ankle joint. See Figure 2 and column 3, lines 14-21. Furthermore inasmuch as applicant has defined polyurethane to be flexible and non-stretchable, frame **21** which can be made of polyurethane is therefore considered to be flexible and non-stretchable. See column 3, lines 2-4.

6. Claims 1-2, 4-8, 12-14, 24 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Saillet (5,901,469). Saillet '469 discloses all the limitations of the claims such as a sports boot of flexible type that retains its qualities of comfort while at the same time ensuring the transmission of essential forces required for the good control and mastery of the gliding sports in every condition of use comprising: an outer sole **5** and an external upper **2** overlying the outer sole **5** and covering a user's foot and lower leg, the upper including a flexible, substantially

non-stretchable frame 3, with a dorsal portion 31. Note that the cut-outs 430, 431 and 432 allow the flexing of the frame 3. See Figures 2 and 3 embodiments.

7. Claims 1-3 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown (4,869,001). Brown '001 discloses all the limitations of the claims such as a sports boot comprising an outer sole and an external upper overlying the outer sole and covering a user's foot and lower leg, the upper including a flexible frame 21. See Figure 36 embodiment.

8. Claims 1-15, 16-18, 24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshizaki et al. (5,498,033). Hoshizaki '033 discloses all the limitations of the claims such as a sports boot that permits a certain amount of dorsal and plantar flexion, comprising an outer sole and an external upper overlying the outer sole and covering a user's foot and lower leg, the upper including a flexible (capable of bending during use), plastic (which is substantially non-stretchable, since it improves the overall strength and rigidity of the skate boot) frame 1 having several cut-out areas which allow for a certain amount of flexion. See column 2, lines 11-13 and Figures 1 and 4 embodiments. Note recess 5 and 15 and notch 8 in Figure 4 embodiment.

### ***Response to Arguments***

9. Applicant's arguments filed July 09, 2001 have been fully considered but they are not persuasive. Inasmuch as applicant has defined a flexible and non-stretchable material, all of the above cited references teach a material which is flexible type that retains its qualities of comfort while being substantially non-stretchable at the same time to ensure the transmission of essential forces required for the good control and mastery in every condition of use.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is 703-305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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Jila M. Mohandesi

Examiner

Art Unit 3728

JMM

September 19, 2001

  
Jila M. Mohandesi  
Examiner  
Art Unit 3728

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.